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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,124	12/21/1999	MITCH A. BRISEBOIS	71493-591	9802

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EXAMINER

HOM, SHICK C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 03/26/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

84

Office Action Summary

Application No.

09/466,124

Applicant(s)

BRISEBOIS ET AL.

Examiner

Shick C Hom

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2666

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The disclosure is objected to because of the following informalities: in page 1 line 5 update status of Brisebois et al. application.

Appropriate correction is required.

Claim Objections

3. Claims 1-35 are objected to because of the following informalities: in claims 2-10, 13-17, 19-21 line 1 delete "An apparatus" and insert ---The apparatus---, because they're reciting the apparatus of claims 1 and 12, respectively. In claim 18 line 1 delete "A computing apparatus" and insert ---The apparatus---. In claims 23-27 line 1 delete "A private network" and insert ---The private network---, because they're reciting the private network of claim 22. In claims 29-32, 34 line 1

Art Unit: 2666

delete "A wireless network" and insert ---The wireless network--- and in claims 33 and 35 line 1 delete "An interface apparatus" and insert ---The interface apparatus---. In page 48 of the specification line 16 delete typo "35" and ---36---, because there are two claims numbered as 35. In claim 1 line 9, claim 11 line 9, claim 12 line 10, claim 22 line 13, claim 28 line 11, claim 32 line 16, claim 34 line 8 the words "a data unit" seem to refer back to "a data unit" recited in claim 1 line 8, claim 11 line 8, claim 12 line 9, claim 22 line 10, claim 28 line 10, respectively. If this is true, it is suggested changing "a data unit" to ---the data unit---. In claim 2 lines 5-6, claim 3 lines 6-7, claim 5 lines 4-5, claim 13 lines 4-5, claim 23 line 5 the words "a private network group" seem to refer back to "a private network group" recited in claim 1 line 6, claim 13 line 7, claim 22 line 8, respectively. If this is true, it is suggested changing "a private network group" to ---the private network group---. In claim 8 line 5, claim 21 line 5 the words "a type" seem to refer back to "a type" recited in claim 8 line 2 and claim 21 line 2, respectively. If this is true, it is suggested changing "a type" to ---the type---. In claim 33 line 4, claim 35 line 4 the words "digital data" seems to refer back to "digital data" recited in claim 32 line 8. If this is

Art Unit: 2666

true, it is suggested changing "digital data" to ---the digital data---. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 6-7, 13-20, 22-27, 29, and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6 lines 6, 8 which recite "the first group" and "the second group," respectively, lack clear antecedent basis because no first group nor second group have been previously recited in the claims and therefore the limitation is not clearly understood. In claim 6 line 10 which recite "the apparatus" is not clear as to whether it is reciting the apparatus of claim 1 line 1 or the second apparatus of claim 6 line 9. In claim 13 lines 3-4 and 5-6 and claim 19 lines 5-6 and 8 which recite "the plurality of telephone stations" and "the at least two telephone stations," respectively, lack clear antecedent basis. In claim 14 lines 3-4 which recite "the particular mobile telephone station" lacks clear antecedent basis. In claim 16 lines 7 and 8, claim 25 lines 6-7 which recite "the resulting data unit"

Art Unit: 2666

and "the data network" respectively, lack clear antecedent basis.

In claim 22 lines 9 and 11 which recite "a communication link" is not clear as to whether said communication link is related to the communication links recited in claim 22 line 4. In claim 22 line 12 which recite "a second one" is not clear as to where is the first one. In claim 23 line 2 which recite "the plurality of groups" lack clear antecedent basis. In claim 24 line 26 which recite "second ones" is not clear as to whether it is reciting --the second ones--- of claim 22 line 12. In claim 29 lines 2-3 and 4 which recite "the bandwidth" and the base transceiver stations" lack clear antecedent basis. In claim 34 lines 1-2 which recite "at least one" is not clear as to whether it is reciting ---the plurality--- as in claim 28 line 4.

Claims 7, 15, 17, 20, 26-27, and 35 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claims 6, 13, 19, 22, and 34, respectively.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2666

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[®] of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 5, 11, 12-14, 22-23, 28, and 36 (renumbered) rejected under 35 U.S.C. 102(e) as being anticipated by Pfundstein.

Pfundstein discloses all the subject matter now claimed. Note col. 1 lines 14-46 which recite a mobile-radio network having a base station for servicing a radio cell and a device for establishing and releasing calls between two mobile subscribers and a fixed network subscriber wherein a virtual private network is installed in the mobile-radio network by forming groups in

Art Unit: 2666

which different mobile subscribers are logically assigned to each other and each private network comprising such a group being a virtual private branch exchange having its own call directory so that the mobile subscribers can access the private branch exchange by dialing a four-digit number and make cost-effective calls within their group, meaning within their virtual private network clearly anticipate the network including mobile stations maintaining communication link with a base transceiver station for enabling communication between a first and second mobile station comprising means for grouping mobile stations as members of a private network group as in claims 1, 11, 12, 22, 28, and 36. Col. 4 line 66 to col. 5 line 6 which recite that using the mobile subscriber identity number, the home location register HLR determines whether the mobile subscriber is also assigned at least one logic data set which identifies him as a subscriber of a private network clearly anticipate means for determining if the first mobile station sending data and the second mobile station scheduled to receive data are both members of the private network group and enabling communication if they are both members of the group as in claims 1, 11, 12, 22, 28, 36 and the Home Location Registration HLR and node registration as in claims 2, 5, 13, 14, 23, 24. Col. 5 lines 42-62 which recite accessing the call

Art Unit: 2666

number directory of the virtual private network wherein the number entered by subscriber is logged as an address dialing number converted by the call number directory into a subscriber number that is adapted to the mobile-radio protocol being sent to the home location register HLR, where a reference list indicating the ID number of the desired subscriber wherein the call is connected using this ID number clearly anticipate means for grouping includes means for listing the HLRs of the mobile stations within a private network group table and means for determining includes means for determining if mobile stations are listed within the private network group table as in claims 2, 5, 13. Col. 1 lines 38-47 which recite the virtual private network being constructed with the aid of an intelligent network containing so-called service control points INSCP1 and INSCP2, which are connected to exchanges PISDN1 or PISDN2 in the mobile-radio network clearly anticipate the use of an intelligent peripheral coupled within a wireless network as in claim 26.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2666

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In

considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103[®] and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-4, 6-8, 15-21, 24-27, and 30-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Pfundstein as applied to claims 1, 2, 5, 11, 12-14, 22-23, and 28 above, and further in view of Voit et al.

Pfundstein did not teach the use of data having a destination address as in claims 3, 6, the address being Internet

Art Unit: 2666

Protocol IP address as in claims 4, 7, 17, 20, the data address corresponding to the second apparatus as in claims 15, 19, 24, the data being a type not requiring limited access being communicated to the mobile stations as in claims 8, 21, the means for attaching a header to the data whereby the header comprising the destination address for routing as in claims 16, 25, the server coupled to a LAN as in claim 18, 27, the personal computer with the wireless modem as in claim 31, including the mobile stations located within the first and second cell clusters as in claims 24 and 30.

Voit et al. teach that it is known to provide packets that are broadcast to all subnetworks in the internetwork wherein when a router receives a packet from some source it uses its routing tables to forward the packets on the subnetwork as set forth at col. 38-50 in the field of digital and multiplex communications for the purpose of distributing packets to each subnetwork in the internetwork with minimum cost which clearly anticipate the data being a type not requiring limited access being communicated to the mobile stations as in claims 8, 21. Col. 7 line 61 to col. 8 line 6 which recite multicasting message from a sending station to a plurality of receiving stations within a network by

Art Unit: 2666

maintaining tables of subnetworks with multicast receiving stations or tables of multicast receiving stations and by including appropriate routing information in the header of multicast messages clearly anticipate the means for attaching a header to the data whereby the header comprising the destination address for routing as in claims 16, 25. Col. 8 lines 59-64 which recite using an enhanced domain name server capable of using a single Domain Name address at an Internet telephone to communicate with another Internet telephone or telephones on the PSTN, both wireline and wireless and col. 11 lines 31-41 which recite the PCS connect to the network through an Internet access server for providing a compatible interface to the respective PCS, modem, ISDN or LAN and protocol conversion and interfacing, as necessary, for two-way data communication over the particular high speed link to the packet data Internet clearly anticipate the use of data having a destination address as in claims 3, 6, the address being Internet Protocol IP address as in claims 4, 7, 17, 20, the data address corresponding to the second apparatus as in claims 15, 19, 24, the server coupled to a LAN as in claim 18, 27, and the personal computer with the wireless modem as in claim 31. Col.19 lines 50-59 which recite the mobility controllers MC connects to antennas for a number of cell sites to

Art Unit: 2666

provide wireless communication services to PCS portable handsets and/or other wireless mobile communication devices whereby the cellular MC controls communications via a number of macrocells and the personal Communication Service PCS MC controls communications via a number of microcells clearly anticipate the mobile stations located within the first and second cell clusters as in claims 24 and 30.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the use of data having a destination address, the address being Internet Protocol IP address, the data address corresponding to the second apparatus, the data being a type not requiring limited access being communicated to the mobile stations, the means for attaching a header to the data whereby the header comprising the destination address for routing, the server coupled to a LAN, the personal computer with the wireless modem, including the mobile stations located within the first and second cell clusters as taught by Voit et al. to the system of Pfundstein because Voit et al. teach the desirable advantage of distributing packets to each subnetwork in the internetwork with minimum cost and said distributing packets with minimum cost being desirable to achieve more efficient system operation in Pfundstein.

Art Unit: 2666

9. Claims 9 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfundstein as applied to claims 1 and 28 above, and further in view of Wellig.

Pfundstein did not teach the means for sending bandwidth request signal prior to enabling communication as in claim 9 and adjusting the bandwidth as in claim 29.

Wellig teaches that it is known to provide a request to increase bandwidth and allowing the receiver to adjust the bandwidth to meet the need to supply enough bandwidth for message retransmission traffic as set forth at col. 1 lines 13-25 and col. 2 lines 49-57 in the field of digital and multiplex communications for the purpose of providing adaptive allocation of feedback bandwidth to conserve bandwidth which clearly anticipate the means for sending bandwidth request signal prior to enabling communication as in claim 9 and adjusting the bandwidth as in claim 29.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide means for sending bandwidth request signal prior to enabling communication and means for adjusting the bandwidth as taught by Wellig to the

Art Unit: 2666

system of Pfundstein because Wellig teaches the desirable advantage of providing adaptive allocation of feedback bandwidth to conserve bandwidth and said conserving bandwidth being desirable to achieve more efficient system operation in Pfundstein.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfundstein as applied to claim 1 above, and further in view of Nakamura.

Pfundstein did not teach means for sending an error signal if stations are not both members of the private network group as in claim 10.

Nakamura teaches that it is known to judge whether the receipt dial number is the extension number or not and the error notification is sent to the sender in the case where it is not any extension number as set forth at col. 9 lines 63-67 in the field of telephonic for the purpose of switching extension number which can be changed without the operation by a switch operator which clearly anticipate the means for sending an error signal if stations are not both members of the private network group as in claim 10.

Art Unit: 2666

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide means for sending an error signal if stations are not both members of the private network group as taught by Nakamura to the system of Pfundstein because Nakamura teaches the desirable advantage of switching extension number which can be changed without the operation by a switch operator and said switching without the operation by a switch operator being desirable to achieve more efficient system operation in Pfundstein.

Allowable Subject Matter

11. Claims 32-35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Emery et al. disclose a personal communications service using wireline/wireless integration.

Art Unit: 2666

Chiniwala et al. disclose a virtual private network for a telephone network.

13. **Any response to this nonfinal action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (2600 Receptionist at (703) 305-4750).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from 8:00 am to 5:30 pm EST and out of office on alternate Friday.

Art Unit: 2666

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao, can be reached at (703) 308-5463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



SH

March 22, 2003